

**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant:	Dennis G. Earnshaw, et al.	Examiner:	Naresh Vig
Application No.	09/849,513	Group Art Unit:	3629
Filed:	May 5, 2001	Docket No.	70325-040017
Title:	<b><i>ELECTRONIC TRANSACTION SERVICE SYSTEM</i></b>		
Customer No.:	33717		

**RESPONSE TO OFFICE ACTION**

Dear Sir:

This paper is responsive to the Office Action mailed March 24, 2006.

**Amendments** to the claims begin on page 2.

A **Response** to examiner's rejections begin on page 11.

**Remarks** begin on page 14.

## AMENDMENTS TO THE CLAIMS

Please amend the claims with the following list of claims.

**Claim 1 (currently amended):** An electronic business transaction service method for conducting a business transaction over a computer network, comprising:

creating on a first computer an electronic business transaction document to be directed to a plurality of recipient parties to a business transaction, the electronic business transaction document being created by a business management software program, the electronic business transaction document including a preferred communication format indicator for each of the plurality of recipient parties of the business transaction, the electronic business transaction document being directed to at least one recipient party in a computer communication format and to at least one other recipient party in a non-computer communication format;

transmitting the electronic business transaction document over the computer network to a network-connected transaction service server computer;

determining at the transaction service server computer a preferred communication format for each of the plurality of recipient parties of the business transaction, the preferred communication format being determined by an electronic business management software residing at the transaction service server computer that interprets the preferred communication format indicator of each of the plurality of recipient parties of the business transaction;

if the transaction service server computer determines that the preferred communication format of a recipient party is a computer communication format, sending the electronic business transaction document from the transaction service server computer to a first recipient party using a computer communication format; and

if the transaction service server computer determines that the preferred communication format of a party is a non-computer communication format, sending the electronic business transaction document from the transaction service server computer to a second recipient party

using a user preferred non-computer communication format, wherein the user preferred non-computer communication format can be telephonic facsimile or regular mail.

**Claim 2 (previously presented):** The method of claim 1 in which the preferred communication format includes telephonic facsimile.

**Claim 3 (previously presented):** The method of claim 1 wherein the preferred communication format includes regular mail, further comprising printing the electronic business transaction document as a printed copy, and mailing the ~~wherein~~ a printed copy of the electronic business transaction document ~~is mailed~~ to a recipient party.

**Claim 4 (previously presented):** The method of claim 1 further comprising storing in an electronic address book associated with the business management software program address information for each party and the preferred communication format indicator for each of the plurality of recipient parties of the business transaction indicating the one of the computer and non-computer communication formats in which to transmit communications to the party.

**Claim 5 (previously presented):** The method of claim 4 wherein adding a recipient party to the electronic business transaction document automatically associates with the recipient party the preferred communication format indicator.

**Claim 6 (previously presented):** The method of claim 1 further comprising charging a fee for each recipient party to which the electronic business transaction document is sent from the transaction service server computer.

**Claim 7 (previously presented):** The method of claim 1 in which the business management software program is capable of automatically populating and extracting information from the electronic business transaction document, the method further including transmitting a business management software component or access to the business management software component with the electronic business transaction document in the computer format to the at least one recipient party, if it is determined that the at least one recipient party is not capable of viewing the electronic business transaction document, the business management software component not

being capable of automatically populating and extracting information from electronic business transaction documents.

**Claim 8 (original):** The method of claim 1 in which the electronic business transaction document includes a markup language computer file.

**Claim 9 (original):** The method of claim 8 in which the markup language computer file includes Extensible Markup Language.

**Claim 10 (original):** The method of claim 1 in which the business transaction relates to a construction project.

**Claim 11-13 (canceled)**

**Claim 14 (currently amended):** In computer readable media, electronic business transaction service software for conducting a business transaction over a computer network, comprising:

software for creating on a first computer an electronic business transaction document to be directed to a plurality of recipient parties to a business transaction, the electronic business transaction document being created by a business management software program, the electronic business transaction document including a preferred communication format indicator for each of the plurality of recipient parties of the business transaction, the electronic business transaction document being directed to at least one recipient party in a computer communication format and to at least one other recipient party in a non-computer communication format;

software for transmitting the electronic business transaction document over the computer network to a network-connected transaction service server computer;

software for determining at the transaction service server computer a preferred communication format for each of the plurality of recipient parties of the business transaction, the preferred communication format being determined by an electronic business management software residing at the transaction service server computer that interprets the preferred

communication format indicator of each of the plurality of recipient parties of the business transaction;

software for sending the electronic business transaction document from the transaction service server computer to a first recipient party using a computer communication format if the transaction service server computer determines that the preferred communication format of a recipient party is a computer communication format; and

software for sending the electronic business transaction document from the transaction service server computer to a second recipient party using a non-computer communication format if the transaction service server computer determines that the preferred communication format of a party is a non-computer communication format, wherein the non-computer communication format can be telephonic facsimile or regular mail.

**Claim 15 (previously presented):** The media of claim 14 further software for storing in an electronic address book associated with the business management software program address information for each party and the preferred communication format indicator for each of the plurality of recipient parties of the business transaction indicating the one of the computer and non-computer communication formats in which to transmit communications to the party.

**Claim 16 (previously presented):** The media of claim 15 wherein adding a recipient party to the electronic business transaction document automatically associates with the recipient party the preferred communication format indicator.

**Claim 17 (previously presented):** The media of claim 14 further comprising software for charging a fee for each recipient party to which the electronic business transaction document is sent from the transaction service server computer.

**Claim 18 (original):** The media of claim 14 in which the business transaction relates to a construction project.

**Claim 19 (currently amended):** An electronic business transaction service method for conducting a business transaction over a computer network, comprising:

receiving from a client computer an electronic business transaction document that is compatible with a business management software program, the electronic business transaction document being directed in one or more communication formats to plural recipient parties to a business transaction, the electronic business transaction document being created by a business management software program in the client computer, the electronic business transaction document including a preferred communication format indicator for each of the plurality of recipient parties of the business transaction, wherein the electronic business transaction document is received by a transaction service server computer communicating~~ing~~ with the client computer through a computer network;

determining at the transaction service server computer a preferred communication format for each of the plurality of recipient parties of the business transaction, the preferred business transaction document communication format being determined by an electronic business management software residing at the transaction service server computer that interprets the preferred communication format indicator of each of the plurality of recipient parties of the business transaction;

if the transaction service server computer determines that the preferred business transaction document communication format of a party is a computer communication format, sending the electronic business transaction document from the transaction service server computer to a first recipient party using a computer communication format; and

if the transaction service server computer determines that the preferred business transaction document communication format of a party is a non-computer communication format, sending the electronic business transaction document from the transaction service server computer to a second recipient party using a non-computer communication format.

**Claim 20 (original):** The method of claim 19 in which one of the preferred communication formats includes telephonic facsimile.

**Claim 21 (previously presented):** The method of claim 19 further comprising storing in an electronic address book associated with the business management software program address information for each party and the preferred communication format indicator for each of the plurality of recipient parties of the business transaction indicating the one of the computer and non-computer communication formats in which to transmit communications to the party.

**Claim 22 (previously presented):** The method of claim 21 wherein adding a recipient party to the electronic business transaction document automatically associates with the recipient party the preferred communication format indicator.

**Claim 23 (previously presented):** The method of claim 22 further comprising manually changing the preferred communication format automatically associated with the recipient party prior to sending the electronic business transaction document to the recipient party.

**Claim 24 (previously presented):** The method of claim 19 further comprising charging a fee for each recipient party to which the electronic business transaction document is sent from the transaction service server computer.

**RESPONSE TO OBJECTIONS AND REJECTIONS**

Claims 1-10, and 14-24 are pending.

Claims 11-14 have been canceled without prejudice or disclaimer and consistent with the applicants' election.

In the Office Action dated March 24, 2006 ("Office Action"), the examiner has made rejections and objections which are hereby addressed as follows.

***Miscellaneous***

The attorney docket number has changed. The new attorney docket number is now 70325-040017. Applicants request that the new attorney docket number be used in any future communication.

***Claim Objections***

Claim 1, 14 and 19 have been amended to correct minor informatlities noted by the Examiner. Claim 3 has been amended to include a printing step as required by the Office Action.

***Claim Rejections - 35 U.S.C. § 103(a)***

Claims 1-10, 14-24 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Henry U.S. Patent No. 6,424,426 ("Henry"), in view of Akimoto, U.S. Patent No. 6,775,711 ("Akimoto"). Applicants traverse the Examiner's rejections for at least the following reasons.

Henry does not teach a business management software program. In the Office Action, the Examiner states "the electronic business transaction document being created by a business management software program (email)." It is not clear to Applicants what is referred to by "email." Applicants presume that "email" may refer to an email client application. In Henry, there is no email client application involved in creating the electronic business document. Henry teaches a fax page that can be filled out and transmitted via facsimile to an email address. The



document to be sent is created by a user and the user handwrites or types the email addresses on a form. See Henry Figure 4. “[T]he user fills in the letterboxes, in normal handwriting, with the final email address(es) it wishes to send to, e.g., "john\_doe@generic.com". Alternatively, the email address can be printed in a machine-readable format.” Therefore, the form is filled out by a user, and is not created by a business management software program. Applicants submit that Henry does not disclose the limitations that the Examiner has indicated to be taught in Henry.

In addition, the Office Action has further included Akimoto to cure the deficiency of a transaction service center as disclosed in the claims. The Examiner states that “Akimoto teaches determining at the transaction service server computer a preferred communication format for each of the plurality of recipient parties of the business transaction [...]” This is incorrect. Akimoto does not teach the transaction server making such determination. Applicants respectfully request that the Examiner specifically point out where in Akimoto it is disclosed determining at the transaction service server computer a preferred communication format for each of the plurality of recipient parties.

On the contrary, Akimoto teaches whether the address is in suitable format, not whether there is an indicator of a preferred format for the recipient party: “For this reason, it is determined whether or not the edited recipient address is a suitable format (step T13). If the edited recipient address is not the suitable format, error processing is performed (step T14). Then, if the edited recipient address is the suitable format, transmission processing is performed (step T15).” See Akimoto Column 8, Line 60-65.

Thus, in Akimoto, a determination of whether the address is in a suitable format is disclosed. There is no mention of determining a preferred communication format for each recipient party of a business transaction. Determining whether an address is in the correct format does not imply determining the communication format preferred by a recipient party. Therefore, Applicants submit that Akimoto does not disclose the limitations for what it is cited.

### ***Conclusion***

Therefore, Applicants submit that the rejection of Claims 1, 14 and 19 be withdrawn. Further, claims 2-10, 15-18 and 20-21 depend respectively from independent claims 1, 14 and 19. Therefore, Applicants also submit that the rejections of these claims also be withdrawn.

**RESPONSE TO REQUIREMENT UNDER 37 C.R.F. 111(c)**

The Examiner has requested that US Patent 5,805,810 to Maxwell, and Japanese Patent JP02000285042A to Akimoto be fully considered. Applicants consider the references as follows.

Akimoto

The Japanese reference discloses” “The image communication device is provided with an address analysis means 207 for analyzing an inputted electronic mail address, a means 207 for executing processing corresponding to a specific identification(ID) code at the time of detecting the ID code and a transmission means for transmitting the processed data in accordance with an electronic mail transfer protocol. Akimoto does not teach any of the elements claimed:

“Creating on a first computer an electronic business transaction document to be directed to a plurality of recipient parties to a business transaction, the electronic business transaction document being created by a business management software program, the electronic business transaction document including a preferred communication format indicator for each of the plurality of recipient parties of the business transaction, the electronic business transaction document being directed to at least one recipient party in a computer communication format and to at least one other recipient party in a non-computer communication format.

For example, Akimoto does not disclose a preferred communication format indicator. An ID code is disclosed in Akimoto, however, the ID code is not disclosed as being a preferred communication format indicator. In addition, Akimoto does not teach an electronic business transaction document being created by a business management software program.

Furthermore, Akimoto does not teach:

“Determining at the transaction service server computer a preferred communication format for each of the plurality of recipient parties of the business transaction, the preferred communication format being determined by an electronic business management software

residing at the transaction service server computer that interprets the preferred communication format indicator of each of the plurality of recipient parties of the business transaction.”

Maxwell

Maxwell transmits an email, locates in a database an identifier for the sender and an identifier for the recipient specified in the email message, and generates a mail object using the address information in the database for the sender and the recipient (See Maxwell Abstract). Therefore, Maxwell does not teach:

“Creating on a first computer an electronic business transaction document to be directed to a plurality of recipient parties to a business transaction, the electronic business transaction document being created by a business management software program, the electronic business transaction document including a preferred communication format indicator for each of the plurality of recipient parties of the business transaction, the electronic business transaction document being directed to at least one recipient party in a computer communication format and to at least one other recipient party in a non-computer communication format.”

Maxwell does not create the electronic business transaction document as claimed. Maxwell does not include preferred communication format indicator for each of the plurality of recipient parties of the business transaction as claimed. In Maxwell, the document is directed to recipients in non-computer communication format only.

In addition, Maxwell does not teach:

“Determining at a transaction service server computer a preferred communication format for each of the plurality of recipient parties of the business transaction, the preferred communication format being determined by an electronic business management software residing at the transaction service server computer that interprets the preferred communication format indicator of each of the plurality of recipient parties of the business transaction.” Maxwell does not determine at a transaction service server computer a preferred communication format for each of the plurality of recipient parties of the business transaction.

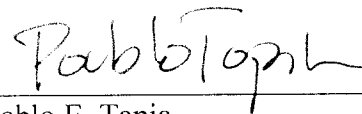
Accordingly, Applicants submit that the claims as presented are not anticipated or rendered obvious by Maxwell, Akimoto, or a combination thereof.

**REMARKS**

In view of the above, it is submitted that this application is now in good order for allowance, and such early action is respectfully requested. Should matters remain that the Examiner believes could be resolved in a telephone interview, the Examiner is requested to telephone the Applicants' undersigned attorney at (310) 586-6512.

The Director is authorized to charge any additional fee(s) or any underpayment of fee(s), or to credit any overpayments to Deposit Account Number 50-2638, Deposit Account Name Greenberg Traurig, LLP. Please ensure that the Attorney Docket Number 70325-040017 is referred to when charging any payments or credits for this case.

Respectfully submitted,



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Date: August 22, 2006

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LA 126601099v1 8/21/2006